



# Search Report

## EIC 1700

STIC Database Tracking Number 246856

To: MELVIN MAYES  
Location: REM-7D13  
Art Unit: 1791  
Thursday, January 03, 2008

Case Serial Number: 08/940815

From: KENDRA BANKS  
Location: EIC1700  
REM-4B28 / REM-4A28  
Phone: (571)272-2516

kendra.banks@uspto.gov

### Search Notes

Examiner MAYES:

3 Cases Reported

US 5,393,368



PATNO IS 5393368

DATE: JANUARY 3, 2008  
LIBRARY: PATENT  
FILE: ALL

Your search request is:  
PATNO IS 5393368

Number of PATENTS found with your search request through:  
LEVEL 1... 1

Your search request has found 1 PATENT through Level 1.  
To DISPLAY this PATENT press either the KWIC, FULL, CITE or SEGMENTS key.  
To MODIFY your search request, press the M key (for MODIFY) and then the ENTER key.

For further explanation, press the H key (for HELP) and then the ENTER key.

LEVEL 1 - 1 PATENT

1. 5393368 , February 28, 1995 , Correction tape dispenser, Stevens, Christopher J. - Reading, United Kingdom (GB), 192471 (08), March 4, 1994 - ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS)., GILLETTE COMPANY, THE A DE CORP. PRUDENTIAL TOWER BUILDING BOSTON, MA 02199, Reel and Frame Number: 006889/0056, The Gillette Company, Boston, Massachusetts, United States (US), United States company or corporation (02) , July 18, 2001 - ASSIGNMENT OF ASSIGNORS INTEREST (SEE DOCUMENT FOR DETAILS)., BEROL CORPORATION 29 E. STEPHENSON STREET FREEPORT, ILLINOIS, 61032, Reel and Frame Number: 011987/0649

CORE TERMS: tape, tip, spool, correction, dispenser, composition, take-up, ribbon, ridge, feed ...

LEVEL 1 - 1 OF 1 PATENT

UNITED STATES PATENT AND TRADEMARK OFFICE GRANTED PATENT

5393368

February 28, 1995

Correction tape dispenser

REISSUE: September 30, 1997 - Reissue Application filed Ex. Gp.: 1304; Re. S.N.  
08/940,815 (O.G. January 20, 1998)

APPL-NO: 192471 (08)

FILED-DATE: February 7, 1994

GRANTED-DATE: February 28, 1995

CORE TERMS: tape, tip, spool, correction, dispenser, composition, take-up,  
ribbon, ridge, feed ...

5393368 OR 5,393,368

Your search request has found no ITEMS.

To edit the above request, use the arrow keys. Be sure to move the cursor to the end of the request before you enter it.

To enter a new search request, type it and press the ENTER key.

What you enter will be Search Level 1.

For further explanation, press the H key (for HELP) and then the ENTER key.

5393368 OR 5,393,368

Your search request has found 3 CASES through Level 1.  
To DISPLAY these CASES press either the KWIC, FULL, CITE or SEGMENTS key.  
To MODIFY your search request, press the M key (for MODIFY) and then the ENTER key.

For further explanation, press the H key (for HELP) and then the ENTER key.

DATE: JANUARY 3, 2008

CLIENT:  
LIBRARY: PATENT  
FILE: CASES

YOUR SEARCH REQUEST IS:  
5393368 OR 5,393,368

NUMBER OF CASES FOUND WITH YOUR REQUEST THROUGH:  
LEVEL 1... 3

CHRISTOPHER J. STEVENS, Appellant, v. SHIGERU TAMAI, Appellee.  
03-1479

UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

366 F.3d 1325; 2004 U.S. App. LEXIS 8773; 70 U.S.P.Q.2D(BNA) 1765

May 4, 2004, Decided

**SUBSEQUENT HISTORY:** Rehearing denied by, Rehearing, en banc, denied by *Stevens v. Tamai*, 2004 U.S. App. LEXIS 12793 (Fed. Cir., June 10, 2004) US Supreme Court certiorari denied by *Tamai v. Stevens*, 2004 U.S. LEXIS 6979 (U.S., Oct. 18, 2004)

**PRIOR HISTORY:** [\*\*1] Appealed from: United States Patent and Trademark Office Board of Patent Appeals and Interferences. (Interference No. 103,662).

**DISPOSITION:** Reversed and remanded.

**CASE SUMMARY:**

**PROCEDURAL POSTURE:** Appellant patent holder sought review of the decision of the United States Patent and Trademark Office Board of Patent Appeals and Interferences (Board), which granted priority in an interference proceeding to appellee patent holder.

**OVERVIEW:** Although it was filed after appellant's patent application, appellee's patent application was a continuation of a prior application. The notice declaring the interference accorded the later application the benefit of the earlier filing date. Thus, appellee was accorded senior party status. Both parties filed preliminary motions under 27 C.F.R. § 1.633(f). Appellant showed a constructive reduction to practice of February 10, 1993. Appellee's motion was based on two Japanese patent applications. Appellee did not include a required English language translation or an affidavit attesting to its accuracy for the second application. On appeal, the court reversed. By failing to include a translation and affidavit, appellee was not entitled to the benefit of the second application. Thus, the Board erred in awarding him the benefit of the prior Japanese application. Without the benefit of both of these applications, appellee's effective filing date, showing a constructive reduction to practice, was March 29, 1993. As appellant had been accorded an effective filing date of February 10, 1993, he proved a constructive reduction to practice earlier in time than appellee.

**OUTCOME:** The court reversed the Board's decision and remanded the case with instructions for the Board to enter judgment in favor of appellant.

**CORE TERMS:** translation, patent, filing date, accorded, attesting, constructive, disclosure, reduction, accuracy, foreign language, reconsideration, corresponding, reply, abuse of discretion, invention, declaring, notice, final decision, interference proceeding, burden of proof, material facts, foreign country, inter alia, failed to prove, substantial evidence, subject matter, procedural requirements, obviate, conclusion of law, acts required

**LexisNexis(R) Headnotes**

Civil Procedure: Pleading & Practice: Motion Practice: Content & Form  
Patent Law: U.S. Patent & Trademark Office Proceedings: Filing Requirements: General Overview  
Patent Law: U.S. Patent & Trademark Office Proceedings: Interferences: General Overview  
See 37 C.F.R. § 1.637.

Civil Procedure: Discovery: Methods: General Overview  
Evidence: Documentary Evidence: Writings: Transcripts & Translations: Translations  
Patent Law: U.S. Patent & Trademark Office Proceedings: Interferences: General Overview  
See 37 C.F.R. § 1.647.

Patent Law: U.S. Patent & Trademark Office Proceedings: Filing Requirements: General Overview  
Patent Law: U.S. Patent & Trademark Office Proceedings: Interferences: General Overview  
See 37 C.F.R. § 1.639(a).

Civil Procedure: Appeals: Standards of Review: Abuse of Discretion  
Civil Procedure: Appeals: Standards of Review: Clearly Erroneous Review  
Civil Procedure: Appeals: Standards of Review: De Novo Review



366 F.3d 1325, \*, 2004 U.S. App. LEXIS 8773, \*\*;  
70 U.S.P.Q.2D (BNA) 1765

A reviewing court reviews factual determinations of the United States Patent and Trademark Office Board of Patent Appeals and Interferences for substantial evidence, while the court reviews statutory interpretation de novo. The court reviews the Board's application of its permissive interference rules for an abuse of discretion. An abuse of discretion occurs where the decision (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact findings; or (4) involves a record that contains no evidence on which the Board could rationally base its decision.

Patent Law: Claims & Specifications: Enablement Requirement: General Overview

Patent Law: Date of Invention & Priority: Reduction to Practice

Patent Law: U.S. Patent & Trademark Office Proceedings: Interferences: Patentability & Priority Determinations

An interference is a proceeding instituted in the United States Patent and Trademark Office, designed to resolve questions of priority and patentability between two or more parties claiming the same patentable invention. 35 U.S.C.S. § 135; 37 C.F.R. § 1.601(i). To establish priority, parties may rely on earlier filed applications because conception and constructive reduction to practice of the subject matter described in an application occur when the application is filed. If a party is entitled to rely on an earlier filed application and the specification of that application shows a constructive reduction to practice of the count, no further evidence is needed to prove invention as of the filing date of that application.

Patent Law: Claims & Specifications: Enablement Requirement: General Overview

Patent Law: Date of Invention & Priority: General Overview

Patent Law: U.S. Patent & Trademark Office Proceedings: Continuation Applications: Priority

A party to an interference seeking to be accorded the benefit of the filing date of an earlier filed application under 37 C.F.R. 1.633(f) is seeking to establish an effective filing date. When a party to an interference seeks the benefit of an earlier-filed United States patent application, the earlier application must meet the requirements of 35 U.S.C.S. § 120. 35 U.S.C.S. § 119(a) precludes relying on a foreign application for priority benefit when that application was filed more than one year before the filing of the corresponding United States application.

Patent Law: Date of Invention & Priority: General Overview

Patent Law: U.S. Patent & Trademark Office Proceedings: Interferences: General Overview  
See 37 C.F.R. § 1.601(g).

Patent Law: Date of Invention & Priority: General Overview

Patent Law: U.S. Patent & Trademark Office Proceedings: Filing Requirements: General Overview  
See 35 U.S.C.S. § 119(a).

International Trade Law: Trade Agreements: General Overview

Patent Law: Date of Invention & Priority: General Overview

Patent Law: U.S. Patent & Trademark Office Proceedings: Interferences: General Overview  
See 35 U.S.C.S. § 363.

Patent Law: Date of Invention & Priority: General Overview

Subject to 35 U.S.C.S. § 119(a)-(d), 35 U.S.C.S. § 365(a) grants national applications the benefit of corresponding international applications which designated at least one country other than the United States.

Patent Law: Date of Invention & Priority: General Overview  
See 35 U.S.C.S. § 371(c)(2).

Patent Law: U.S. Patent & Trademark Office Proceedings: Filing Requirements: General Overview  
See 35 U.S.C.S. § 372(b)(3).

Patent Law: U.S. Patent & Trademark Office Proceedings: General Overview  
See 35 U.S.C.S. § 2(b)(2)(4).

Administrative Law: Judicial Review: Standards of Review: Abuse of Discretion

Patent Law: Jurisdiction & Review: Standards of Review: General Overview

Patent Law: U.S. Patent & Trademark Office Proceedings: Patent Cooperation Treaty & Provisional Applications

A question of the United States Patent and Trademark Office Board of Patent Appeals and Interferences application of its interferences rules is reviewed for abuse of discretion.

Patent Law: Jurisdiction & Review: Standards of Review: General Overview

The United States Patent and Trademark Office Board of Patent Appeal's interpretation of its own regulations is entitled to substantial deference.

366 F.3d 1325, \*, 2004 U.S. App. LEXIS 8773, \*\*;  
70 U.S.P.Q.2D (BNA) 1765

COUNSEL: Carl E. Moore, Jr., Marshall, Gerstein & Borun LLP, of Chicago, Illinois, argued for appellant. With him on the brief were Sandip H. Patel, Michael R. Weiner, and James P. Zeller.

Edward F. Kenehan, Jr., Armstrong, Westerman & Hattori, LLP, of Washington, DC, argued for appellee. With him on the brief was William F. Westerman.

JUDGES: Before MICHEL, CLEVINGER, and SCHALL, Circuit Judges.

OPINION BY: CLEVINGER

OPINION

[\*1327] CLEVINGER, Circuit Judge.

Christopher J. Stevens appeals a final decision of the United States Patent Office Board of Patent Appeals and Interferences ("Board") granting priority in an interference proceeding to Shigeru Tamai. Because the Board erred in granting Shigeru Tamai the benefit of Japanese Patent Application No. 3-068371, we reverse.

I

Christopher J. Stevens ("Stevens") and Shigeru Tamai ("Tamai") are parties to Interference No. 103,662, declared May 9, 1997. Stevens's involved *U.S. Patent No. 5,393,368* ("the '368 patent") was filed February 7, 1994, and issued February 28, [\*1328] 1995. Tamai's involved Application[\*\*2] No. 08/196,839 ("the '839 application") was filed February 15, 1994. The '839 application is a continuation-in-part of U.S. Patent Application No. 08/030,183 ("the '183 application"), which was filed March 29, 1993. The notice declaring the interference accorded the '839 application the benefit of the filing date of the '183 application. On the basis of the March 29, 1993 filing date, Tamai was accorded senior party status.

Both parties filed preliminary motions under 37 C.F.R. § 1.633(f), which provides that a party may file a preliminary motion "to be accorded the benefit of the filing date of an earlier filed application. See § 1.637(a) and (f)." 37 C.F.R. § 1.633(f) (2003). Rule 637 states in relevant part:

(a) A party filing a motion has the burden of proof to show that it is entitled to the relief sought in the motion. Each motion shall include a statement of the precise relief requested, a statement of the material facts in support of the motion, in numbered paragraphs, and a full

statement of the reasons why the relief requested should be granted. . . .

\*\*\*

(f) A preliminary motion for benefit under § 1.633(f) [\*\*3] shall:

(1) Identify the earlier application.

(2) . . . When the earlier application is an application filed in a foreign country, certify that a copy of the application has been served on all opponents. If the earlier filed application is not in English, the requirements of § 1.647 must also be met.

(3) Show that the earlier application constitutes a constructive reduction to practice of each count. 37 C.F.R. § 1.637 (2003) (emphasis added). Rule 647 describes what a party must do when relying on or producing a document that is written in a language other than English. It states:

When a party relies on a document or is required to produce a document in a language other than English, a translation of the document into English and an affidavit attesting to the accuracy of the translation shall be filed with the document.

37 C.F.R. § 1.647 (2003).

Stevens's motion was based on several European applications showing a constructive reduction to practice as early as February 10, 1993. Tamai did not oppose the motion, which was granted by the Board.

Tamai's motion was based on Japanese Patent[\*\*4] Application No. 3-68371 ("the Japanese '371 application") and PCT Application No. PCT/JP92/00947 ("the PCT '947 application"). Both applications are in Japanese. Tamai filed a translation of the Japanese '371 application with the motion. Stevens opposed the motion, arguing, *inter alia*, that Tamai had not met its burden of proof because the motion "failed to comply with 37 C.F.R. § 1.637" because "no copies of [the Japanese '371 application] and the PCT '947 application were served with the motion pursuant to 37 C.F.R. § 1.637(f)(2) [and] no translation of the PCT '947 application was served with the motion pursuant to 37 C.F.R. § 1.637(f)(2)." In reply, Tamai stated that copies of the Japanese language applications, the Japanese '371 application and the PCT '947 application, while not served with the motion, were in the record. Tamai also submitted an affidavit attesting

that the disclosures of the two foreign language applications were substantially the same. Importantly, with neither the original motion nor the reply did Tamai include an English language translation of the PCT '947 application and[\*\*5] an affidavit attesting to the accuracy of the translation.

The Board denied Tamai's motion for benefit as directed to the PCT '947 application because "Tamai did not supply a [\*1329] translation of the PCT application." Nonetheless, the Board examined the Japanese '371 application and determined that the Japanese '371 application "is a constructive reduction to practice of the count." Accordingly, the Board entered judgment against Stevens.

Despite prevailing in the interference, Tamai requested reconsideration of that part of the Board's decision denying Tamai's motion for benefit as directed to the PCT '947 application. Tamai's request argued that the translation of the PCT '947 application was in the record because the '183 application was in the record and "the U.S. Patent and Trademark Office identified and accepted the '183 application as a translation of Tamai's foreign language PCT application." According to Tamai, the requirements of Rule 647 that "a translation of the document into English and an affidavit attesting to the accuracy of the translation" be provided, were made inconsequential in light of 37 C.F.R. § 1.639(a). n1 Tamai's final comment in[\*\*6] support of its argument, on the last page of the request for reconsideration, states: "If this request is denied, it is respectfully requested that the Board explain how Tamai is entitled to the benefit of the [Japanese '371 application] without the linking PCT application in the chain of priority." Tamai's Req. for Recons. at 7. Stevens opposed Tamai's motion, arguing, *inter alia*:

Stevens agrees with Tamai's apparent position that the Board erred in granting Tamai priority benefit of [the Japanese '371 application] in view of Tamai's failure to satisfy the requirements for obtaining priority benefit of Tamai's PCT application. Because Tamai is not entitled to the priority benefit of the PCT application, the Board also should have denied Tamai's motion for the priority benefit of [the Japanese '371 application].

Stevens's Opp'n to Tamai's Req. for Recons. at 9 (citing 35 U.S.C. § 119(a)).

n1 Rule 639(a) states, in part:

Proof of any material fact alleged in a motion, opposition, or reply must be filed and served with the motion, opposition, or reply unless the proof relied upon is part of the interference file or the file of any patent or application involved in the interference or any earlier application filed in the United States of which a party has been accorded or seeks to be accorded benefit.

37 C.F.R. § 1.639(a) (2003).

-----End Footnotes-----

[\*\*7] The Board agreed to reconsider its final decision, but refused to modify it because, "Tamai was required to file a translation of the PCT application along with the motion. This Tamai did not do." Addressing Tamai's argument that the '183 application was the translation of the PCT '947 application, the Board noted that "Tamai did not state that the '183 application is a translation of the PCT application, attaching same, when the motion for benefit was filed." Also, the Board concluded that Rule 637(f) requires that certain documents have to be filed with a motion for benefit and those requirements were not "obviated" by Rule 639(a). Further, the Board concluded that Tamai's failure to follow the rules prejudiced Stevens, who was entitled to expect that Tamai would follow them. Finally, addressing Tamai's linking argument, the Board concluded that any inconsistency in the treatment of the Japanese '371 application and the PCT '947 application "arises because of Tamai's inconsistent actions in regard to these two applications." However, by not modifying its judgment, the Board affirmed its judgment in favor of Tamai. Stevens appeals the decision on reconsideration, which is a final[\*\*8] decision of the Board. This court has jurisdiction under 28 U.S.C. § 1295(a)(4)(A).

[\*1330] II

We review factual determinations of the Board for substantial evidence, *In re Gartside*, 203 F.3d 1305, 1311-15 (Fed. Cir. 2000), while we review statutory interpretation *de novo*, *Studiengesellschaft Kohle m.b.H. v. Shell Oil Co.*, 112 F.3d 1561, 1564 (Fed. Cir. 1997)

-----Footnotes-----

366 F.3d 1325, \*, 2004 U.S. App. LEXIS 8773, \*\*;  
70 U.S.P.Q.2D (BNA) 1765

(construing 35 U.S.C. § 120). We review "the Board's application of its permissive interference rules for an abuse of discretion." *Brown v. Barbacid*, 276 F.3d 1327, 1332 (Fed. Cir. 2002); see also *Abrutyn v. Giovanniello*, 15 F.3d 1048, 1050 (Fed. Cir. 1994); *Gerritsen v. Shirai*, 979 F.2d 1524, 1527-28 (Fed. Cir. 1992). An abuse of discretion occurs where the decision (1) is clearly unreasonable, arbitrary, or fanciful; (2) is based on an erroneous conclusion of law; (3) rests on clearly erroneous fact findings; or (4) involves a record that contains no evidence on which the Board could rationally base its decision. *Eli Lilly & Co. v. Bd. of Regents of the Univ. of Wash.*, 334 F.3d 1264, 1266-67 (Fed. Cir. 2003)[\*\*9] (citing *Gerritsen*, 979 F.2d at 1529).

### III

On appeal, Stevens argues that the Board erred in granting Tamai's motion for benefit of the Japanese '371 application. According to Stevens, the statutory limits of 35 U.S.C. § 119(a) preclude Tamai directly claiming the benefit of the Japanese '371 application because that application was filed more than one year before the '183 application. In particular, Stevens asserts that in order to obtain the benefit of the Japanese '371 application, Tamai must obtain the benefit of the intervening PCT '947 application. In Stevens's view, because Tamai failed to prove its claim for priority benefit of the PCT '947 application, and cannot therefore obtain the benefit of the Japanese '371 application, Tamai has failed to prove a constructive reduction to practice of the subject matter corresponding to the count prior to the filing date of the '183 application, March 29, 1993. Based on Stevens's preliminary motion, the Board accorded Stevens an effective filing date of February 10, 1993. Because February 10, 1993 is an earlier effective filing date than March 29, 1993, Stevens argues that he should be awarded[\*\*10] judgment in the interference.

Tamai does not argue that his involved application can be accorded the benefit of the Japanese '371 application if he is not accorded the benefit of the PCT '947 application. Rather, Tamai supports the Board's decision in his favor by arguing that the Board erred in not according him the benefit of the PCT '947 application. In particular, Tamai argues that a preliminary motion for benefit is not required for him to be entitled to the benefit of the PCT '947 application, or, alternatively, if a motion for benefit was required, his actions in this case were sufficient to establish entitlement to the benefit of the PCT '947 application.

### IV

As a matter of convenience, we first address Stevens's argument. We agree with Stevens: because Tamai failed to prove his entitlement to the benefit of the PCT '947 application, it was error for the Board to accord Tamai the benefit of the Japanese '371 application.

An interference is a proceeding instituted in the United States Patent and Trademark Office, designed to resolve questions of priority and patentability between two or more parties claiming the same patentable invention. See 35 U.S.C. § 135(2000)[\*\*11] ; 37 C.F.R. § 1.601(i) (2003). To establish priority, parties may rely on earlier filed applications because conception and constructive reduction to practice of the subject matter described in an application occur when the application is filed. See *Hyatt v. Boone*, 146 F.3d 1348, 1352 (Fed. Cir. 1998); *Yasuko Kawai v. Metlesics*, [\*1331] 480 F.2d 880, 885-86 (CCPA 1973). If a party is entitled to rely on an earlier filed application and the specification of that application shows a constructive reduction to practice of the count, no further evidence is needed to prove invention as of the filing date of that application. See *Hyatt*, 146 F.3d at 1352.

A party to an interference seeking to be "accorded the benefit of the filing date of an earlier filed application" under 37 C.F.R. 1.633(f) is seeking to establish an effective filing date. See *id.* at 1351-52. "The effective filing date of an application is the filing date of an earlier application, benefit of which is accorded to the application under 35 U.S.C. 119, 120, 121, or 365 . . . ." 37 C.F.R. § 1.601(g)[\*\*12] ; see also *Hyatt*, 146 F.3d at 1352 ("When a party to an interference seeks the benefit of an earlier-filed United States patent application, the earlier application must meet the requirements of 35 U.S.C. § 120 . . ."). Section 119(a) of title 35 precludes relying on a foreign application for priority benefit when that application was filed more than one year before the filing of the corresponding U.S. application. *Schmierer v. Newton*, 55 C.C.P.A. 1362, 397 F.2d 1010, 1014-15 (CCPA 1968). Section 119(a) reads:

(a) An application for patent for an invention filed in this country by any person who has . . . filed an application for a patent for the same invention in a foreign country . . . shall have the same effect as the same application would have if filed in this country on the date on which the application for patent . . . was first filed in such foreign country, if the application in this country is filed within twelve months from the earliest date on which such foreign application was filed . . . .

35 U.S.C. § 119(a) (2000).

In the matter at hand, the Board held that because[\*\*13] Tamai did not file with his motion for benefit an English language translation of the PCT '947 application and an affidavit attesting to the accuracy of the translation, Tamai had not proven that he was entitled to be accorded the filing date of the '947 application. Nonetheless, the Board granted Tamai's involved application the benefit of the Japanese '371 application, which was filed July 31, 1991, more than one year prior to the filing of the '183 application. Because *section 119* precludes reliance on a foreign application for priority benefit when that application was filed more than one year before the filing of the corresponding U.S. application, see *Schmierer*, 397 F.2d at 1014-15, the Board's conclusion was based on an erroneous conclusion of law, and accordingly, constituted an abuse of discretion.

V

At argument, Tamai conceded that he had no theories or evidence remaining before the Board by which to establish an actual or constructive reduction to practice prior to Stevens's February 10, 1993, date. Tamai agrees that if this court does not grant relief on his argument that a motion for benefit was unnecessary, or alternatively that his motion for benefit[\*\*14] was sufficient, then this court should remand for judgment in favor of Stevens. In Tamai's view, a preliminary motion for benefit is unnecessary because 35 U.S.C. § 363 operates to make the filing date of the Japanese language PCT '947 application the same as that of the '183 application, which according to Tamai is the U.S. national stage application of the PCT '947 application. Further, Tamai asserts that even if the Board could require a preliminary motion for benefit, the acts required to enter the national stage for examination purposes were sufficient acts to satisfy the Board's procedural requirements in this interference. Finally, Tamai argues that 37 C.F.R. § 639(a) combined with the [\*1332]presence in the interference file of both the PCT '947 application and the '183 application obviates the requirement of interference rule 37 C.F.R. § 647 that Tamai serve a translation of the PCT '947 application and an affidavit attesting to the accuracy of the translation with the motion for benefit. Because the Board did not err in requiring a preliminary motion for benefit, because Tamai's compliance with the filing procedures for entering the national stage did not[\*\*15] satisfy the procedural requirements for a preliminary motion for benefit, because Rule 639(a) does not obviate Rule 647, and because Tamai did not attach to his motion a translation of the PCT '947 application and an affidavit attesting to the accuracy of the translation, we hold that the Board was correct in

denying Tamai's claim of benefit of the PCT '947 application. Accordingly, we reverse the Board's decision on reconsideration and remand with instructions to enter judgment in favor of Stevens.

A

Distilled, Tamai's argument that a motion for benefit was unnecessary in this interference rests on the premise that a motion for benefit cannot be required for non-English applications where the applicant has satisfied U.S. filing requirements for prosecution purposes. In this case, Tamai filed the PCT '947 application with the United States Patent and Trademark Office ("Office") for the purpose of entering national stage examination in the United States. Included with the application was the declaration of Tamai that stated "on information and belief," he was, *inter alia*, entitled to priority benefit of the Japanese '371 application. The PCT '947 application was accepted by the [\*\*16]Office as having satisfied the requirements of 35 U.S.C. § 371 and became the '183 application. Tamai asserts, and we assume without deciding that Tamai correctly followed the procedures for filing the PCT '947 application in the United States. Thus, Tamai argues that when the Office accepts a translation of a foreign language international application into the national stage, the Board, in any interference in which the applicant later becomes embroiled cannot require that the applicant seeking the benefit of the foreign language international application prove that the application contains the same disclosure as the national stage application. We disagree.

In its most favorable light, Tamai is stating that there is a conflict between Subpart E--Interferences, 37 C.F.R. §§ 1.601-1.690, which "governs the procedure in patent interferences in the Patent and Trademark Office," 37 C.F.R. § 1.601, and sections 363 and 371(c)(2) of title 35, as they provide authority for national stage applications.

The conflict Tamai suggests simply does not exist. Sections 363 and 371(c)(2) are not inconsistent with the Office's[\*\*17] procedural requirements which insist that a party to an interference seeking the benefit of an earlier filed application prove the same by filing a motion for benefit, and, where applicable, serving a translation of a relied upon non-English language application with an affidavit attesting to the accuracy of the translation. The former sections deal with accepting an international application into national stage examination in the United States while the latter regulations deal with proving whether the application contains a constructive reduction to practice of subject matter corresponding to a count in an interference. In short, in the context of this case,

sections 363 and 371(c)(2), and 37 C.F.R. §§ 1.601-1.690, have little to do with one another.

Section 363 of title 35 establishes that: "An international application designating the United States shall have the effect, from its international filing date under article 11 of the treaty, of a national application for patent regularly filed in the Patent [\*1333] and Trademark Office . . . ." Subject to 35 U.S.C. § 119(a)-(d), section 365(a) of title 35 grants national applications the benefit[\*18] of corresponding international applications which designated at least one country other than the United States. Section 371(c)(2) requires that an applicant filing a national stage application submit "a copy of the international application, unless not required under subsection (a) of this section or already communicated by the International Bureau, and a translation into the English language of the international application, if it was filed in another language." 35 U.S.C. § 371(c)(2) (2000). And, while overlooked by Tamai, 35 U.S.C. § 372(b)(3) permits the Director to "require a verification of the translation of the international application or any other document pertaining to the application if the application or other document was filed in a language other than English." Thus, contrary to what Tamai suggests, the Office is not required to accept an applicant's transmittal letter requesting entry into the national stage as conclusive proof that a foreign language application contains a particular disclosure.

Further, as we have previously held, the broadest of the Office's rulemaking powers is the power to "establish regulations, not[\*19] inconsistent with law, which--(A) shall govern the conduct of proceedings in the Office." 35 U.S.C. § 2(b)(2)(A) (2000) (formerly at 35 U.S.C. § 6(a) (1988), see *Merck & Co. v. Kessler*, 80 F.3d 1543, 1549 (Fed. Cir. 1996); *Gerritsen*, 979 F.2d at 1527). By this grant of power we understand Congress to have "delegated plenary authority over PTO practice, including interference proceedings," to the Office. *Gerritsen*, 979 F.2d at 1527 n.3. The interference rules most pertinent to this case are 37 C.F.R. §§ 1.633(f), 1.637(a) (establishing that the movant has the burden of proof), 1.637(f) (requiring compliance with 1.647 where the earlier filed application is not in English), and 1.647 (requiring, when the earlier filed application is not in English, the filing of "a translation of the document into English and an affidavit attesting to the accuracy of the translation"). We observe that all of these rules appear to reflect a permissible exercise of the Office's authority and also note that Tamai presents no arguments to the contrary.

The interference regulations are designed[\*\*20] to serve the policy of providing "the just, speedy, and inexpensive determination of every interference." 37 C.F.R. § 1.601. It seems appropriate to us that the Office can allocate the burdens associated with this goal in a reasonable manner not inconsistent with the existing statutory scheme. See *Merck & Co.*, 80 F.3d at 1549; *Gerritsen*, 979 F.2d at 1527. In the case of interferences, the Office has provided for a motion procedure that permits a party an opportunity to prove his right to priority benefit of an earlier disclosure. See 37 C.F.R. §§ 1.633(f), 1.637(a), (f). This includes an opportunity to prove priority to foreign language applications. Because a party seeking to be accorded the benefit of a foreign language disclosure is often in the best position to know the content of the disclosure, and because that party hopes to benefit from the content of that disclosure, it seems very reasonable that a party seeking to rely on such a disclosure have the burden of proving its content. In contrast to Tamai's thinking, the Board can require that the cost of a translator capable of attesting in[\*\*21] an affidavit that the disclosure of a Japanese language document, i.e., the PCT '947 application, is the same as the disclosure of a national stage application that purports to be substantially the same, i.e., the '183 application, shall be borne by the party asserting that the latter is an accurate translation of the former.

In view of the reasonableness of the Office's rules governing the procedure in [\*1334] patent interferences, and the substantial deference we accord such rules, see *Merck & Co.*, 80 F.3d at 1549, we cannot agree with Tamai that section 363 overwhelms the Office's interference rules and requires the Board to accord Tamai the benefit of the PCT '947 application merely because he completed the requirements for entering the national stage of examination in the United States.

## B

Next, Tamai asserts that the acts necessary to comply with the procedures he followed in the course of entering the national stage of examination are a sufficient substitute for the acts required by the Office's interference rules. In light of our conclusion that the interference rules at issue are a reasonable exercise of the Office's procedural rulemaking, we hold that[\*\*22] the acts Tamai took with regard to entering the national stage will only suffice to satisfy the requirements of the interference rules if the acts show compliance with the interference rules. Accordingly, this is a question of the Board's application of its interferences rules, an exercise we review for abuse of discretion. See, e.g., *Barbacid*, 276 F.3d at 1332.

The interference rules are quite explicit and we discern no abuse of discretion in the Board's decision that Tamai did not comply with Rules 637(f) and 647. In particular, the Board found that "Tamai did not supply a translation of the PCT application." In its decision on reconsideration, the Board affirmed this fact, stating: "Tamai was required to file a translation of the PCT application along with the motion. This Tamai did not do." This finding of the Board is supported by more than substantial evidence. At argument, Tamai conceded that he did not file with his motion for benefit an English language translation of the PCT '947 application and an affidavit attesting to the accuracy of the translation as required by Rule 647.

In his motion for reconsideration below Tamai argued that the '183 application[\*\*23] was the translation of the PCT '947 application. However, the Board explained why that argument fails. In particular, the Board found that in neither Tamai's preliminary motion for benefit nor in reply to Stevens's opposition thereto did Tamai "state that the '183 application is a translation of the PCT application, attaching same, when the motion for benefit was filed." Because on its face Tamai's motion for benefit does not state that the '183 application is the translation of the PCT '947 application and the record contains no affidavit attesting that the '183 application is an accurate translation of the PCT '947 application, this finding is supported by substantial evidence.

Tamai next argues that to comply with *section 363*, he needed to comply with *section 371(c)(2)*, which requires a translation of the corresponding international application when that application is not in English. According to Tamai, when he presented the Office with a translation of the international application to enter national stage examination that act was sufficient to satisfy Rules 637(f) and 647. As the Board pointed out, however, *section 371(c)(2)* does not require an affidavit attesting to the accuracy[\*\*24] of the translation, while Rule 647 does. Moreover, as our prior discussion indicates, compliance with filing requirements is not sufficient to prove constructive reduction to practice in an interference proceeding.

On appeal, for the first time, Tamai argues that the notice declaring the interference should have accorded him the benefit of the Japanese '371 application and the PCT '947 application. In light of our prior discussion, we think this a matter of the Board's discretion. The Board might, where an international application is in English, and therefore easily accessible in substance to the Board, accord priority to [\*1335] such an application in its notice declaring an interference. However, we discern no requirement that the Board do so in every case, and no

requirement that the Board do so when the application is in a foreign language, which makes it more difficult for the Board to determine whether the disclosure contains a constructive reduction to practice of the invention. In a case where the applicant should be accorded the benefit of an earlier application, but the Board does not accord benefit in the notice declaring the interference, the Board has, by regulation, provided [\*\*25] the procedural protection of a preliminary motion procedure. Under that procedure a party can prove that it should be accorded the benefit of an earlier disclosure. That Tamai understood and had access to this procedural protection is underscored by the fact that Tamai filed a preliminary motion seeking to be accorded the benefit of the Japanese '371 application, the PCT '947 application, and the '183 application.

## C

Tamai also argues that although he never made known to the Board or Stevens that a translation of the PCT '947 application existed in the interference file as the '183 application, Rule 639(a), which requires that "proof of any material fact . . . be filed and served with the motion . . . unless the proof relied upon is part of the interference file . . .," 37 C.F.R. 1.639(a), protects him from having to file a translation and affidavit as required by Rules 637(f) and Rule 647. We disagree.

As a preliminary matter, the Office's interpretation of its own regulations is entitled to substantial deference. *Bd. of Regents of the Univ. of Wash.*, 334 F.3d at 1266. On reconsideration, the Board addressed this argument holding that Rule[\*\*26] 639(a) does not obviate Rules 637(f) and 647. Given that Rules 637(f) and 647 are very clear in requiring the filing of a translation and affidavit with the preliminary motion for benefit, we defer to the Board's interpretation that Rule 639(a) and Rules 637(f) and 647 are separate rules that must be followed by parties to an interference. Moreover, we note that Tamai's argument on this point is undercut by the fact that his motion and reply did not notify the Board or Stevens that the '183 application was the translation of the PCT '947 application. Had Tamai alerted the Board and Stevens to the presence of the translation, and filed an affidavit attesting that the '183 application was an accurate translation of the PCT '947 application, the Board might have been more lenient.

## VI

We have considered Tamai's remaining arguments and we find them either irrelevant or unpersuasive. In conclusion, we find that the Board did not abuse its discretion in refusing to award Tamai the benefit of the

366 F.3d 1325, \*, 2004 U.S. App. LEXIS 8773, \*\*;  
70 U.S.P.Q.2D (BNA) 1765

PCT '947 application. However, because Tamai was not entitled to the benefit of the PCT '947 application, the Board erred in awarding Tamai the benefit of the Japanese '371 application. Without<sup>1</sup> the benefit of the PCT '947 application and the Japanese '371 application, Tamai's effective filing date, showing a constructive reduction to practice, is March 29, 1993. Because the Board granted Stevens's motion for benefit, according him an effective filing date of February 10,

1993, Stevens has proved a constructive reduction to practice earlier in time than Tamai. Accordingly, we remand to the Board with instructions to enter judgment for Stevens.

**COSTS**

No costs.

**REVERSED AND REMANDED.**



CHRISTOPHER J. STEPHENS (Patent No. 5,393,368) , v. SHIGERUTAMAI (Application 08/196,839).  
Patent Interference No. 103,662

BOARD OF PATENT APPEALS AND INTERFERENCES

2004 Pat. App. LEXIS 176; 74 U.S.P.Q.2D (BNA) 1841

September 14, 2004, Filed; September 14, 2004, Decided

[\*1]

Before: McKELVEY, Senior Administrative Patent Judge, and SCHAFER and TORCZON, Administrative Patent Judges.

OPINION:

The opinion in support of the decision being entered today is not binding precedent of the Board.

JUDGMENT - RULE 658

PER CURIUM

A panel of this board issued a final decision in this interference awarding priority against Stevens (Paper 78) which was adhered to on reconsideration (Paper 82). Stevens appealed to the United States Court of Appeals for the Federal Circuit. The Federal Circuit reversed and remanded "with instructions to enter judgment for Stevens." *Stevens v. Tamai*, 366 F.3d 1325, 1335, 70 USPQ2d 1765, 1773 (Fed. Cir. 2004). Tamai requested rehearing and suggested rehearing in banc. which has also been denied.

Section 144 of 35 U.S.C. provides that on appeal, the Federal Circuit

shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue to the Director its mandate and opinion, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.

Accordingly, [\*2] we enter judgment implementing the Federal Circuit's mandate.

ORDER

It is

ORDERED that judgment on priority as to Count I, the only count in this interference, is awarded against SHIGERU TAMAI;

FURTHER ORDERED that SHIGERU TAMAI is not entitled to a patent containing Claims 1-21 of Application 08/196,839 which correspond to Count 1;

FURTHER ORDERED that if there is a settlement agreement and it has not already been filed, attention is directed to 35 U.S.C. § 135(c) and 37 CFR § 1.661; and

FURTHER ORDERED that a copy of this judgment be given an appropriate paper number and entered into the file records of Patent No. 5,393,368 and Application 08/196,839.

Legal Topics:

2004 Pat. App. LEXIS 176, \*; 74 U.S.P.Q.2D (BNA) 1841

For related research and practice materials, see the following legal topics:  
Patent Law: Jurisdiction & Review: Subject Matter Jurisdiction: Appeals  
Patent Law: Ownership: Conveyances: General Overview  
Patent Law: U.S. Patent & Trademark Office Proceedings: General Overview

CHRISTOPHER J. STEPHENS (Patent No. 5,393,368), v. SHIGERUTAMAI (Application 08/196,839).  
Patent Interference No. 103,662

BOARD OF PATENT APPEALS AND INTERFERENCES

2004 Pat. App. LEXIS 185; 74 U.S.P.Q.2D (BNA) 1841

September 14, 2004, Filed; September 14, 2004, Decided

CORE TERMS: translation, domestic, filing date, accorded, final hearing, specification, constructive, reduction, requesting, processing, attesting, accuracy, verified, modify, substantially identical, appropriate relief, reconsideration, disclosure, drawings, enter judgment, regulation, burden of proof, failure to file, subject matter, redeclare, reinstate, awarding, becoming, faithful, deferred

[\*1]

Before: HARKCOM, Acting Chief Administrative Patent Judge.

OPINIONBY: HARKCOM

OPINION:

The opinion in support of the decision being entered today is not binding precedent of the Board.

DECISION ON PETITIONS

Tamai has filed two petitions seeking to, in effect, overturn the decision of the Court of Appeals for Federal Circuit in *Stevens v. Tamai*, 366 F.3d 1325, 70 USPQ2d 1765 (Fed. Cir. 2004) and certain aspects of the final decision of a panel of this Board in this interference which was affirmed by the Federal Circuit in the Stevens appeal. The petitions are denied-in-part and otherwise dismissed. n1

n1 The order entered August 6, 2004, prohibiting filing of further papers pending a decision on Tamai's petitions is rescinded.

Findings of Fact

Tamai's Preliminary Motion for Benefit

F 1. When this interference was declared, Tamai was accorded, for the purpose of priority, the filing date of U.S. Application 08/030,183 (the U.S. parent application). Interference 103,662, Paper 1, p. 3.

F 2. During the preliminary motion phase, Tamai filed a two-page motion under 37 CFR § 1.633(f) for the benefit of the filing date of [\*2] an earlier Japanese PCT and an even earlier Japanese domestic application: (1) PCT/JP92/00947 filed in Japan on July 24, 1992 and (2) Japanese Patent Application 3-68371 filed on July 31, 1991. Interference 103,662, Paper 36.

F 3. Both the PCT and Japanese domestic applications are in the Japanese language.

F 4. Tamai's preliminary motion noted that a verified English translation of the Japanese domestic application had been served with the motion:

A copy of the certified English Translation of JP '371 is attached hereto.

Interference 103,662, Paper 36, p. 1.

F 5. With respect to the PCT application, Tamai did not file or refer to a verified translation of the PCT application as required by 37 CFR §§ 1.637(f) and 1.647:

The party Tamai also moves to be accorded the benefit of the July 24, 1992 filing date of the earlier filed PCT Application No. PCT/JP92/00947 . . . of record.

Interference 103,662, Paper 36, p. 1.

F 6. Sections 1.637(f) and 1.647 require that a party in an interference moving to obtain priority benefit of a foreign patent application must serve a copy of the foreign application on the opponent and, when that application is not in English, serve [\*3] an English translation and affidavit attesting to the accuracy of the translation. 37 CFR §§ 1.637(f) and 1.647.

F 7. Tamai did not provide any explanation why the translation and affidavit required by 37 CFR § 1.637(f) and 1.647 were unnecessary.

F 8. Tamai argued entitlement to the filing dates of both applications "for the same reasons" that the party Tamai was accorded the benefit of the filing of the Tamai U.S. parent application. Interference 103,662, Paper 36, p. 1.

F 9. Tamai also asserted that the disclosure of the PCT is "substantially the disclosure" of the Japanese domestic application and that the translation of the Japanese domestic application was "substantially identical" to the specification of the U.S. parent application:

The party TAMAI is entitled to the benefit of the filing dates of both JP '371 and PCT '947 for the same reasons that the party TAMAI was accorded the benefit of the filing date of the parent U.S. Patent Application S.N. 08/030,183 (hereinafter, the '183 Application), filed March 29, 1993. The drawings of JP '371 and PCT '947 are exactly identical to the drawings of the '183 Application. The certified English language translation of JP [\*4] '371 is substantially identical to the specification of the '183 Application, and the PCT '947 specification is substantially the disclosure of JP '371.

Interference 103,662, Paper 36, pp. 1-2.

F 10. Stevens opposed the preliminary motion. Interference 103,662, Paper 31.

F 11. Stevens argued that the Tamai's preliminary motion did not comply with 37 CFR § 1.637 for a number of reasons including the failure to provide a copy and a translation of the PCT application:

The motion failed to comply with 37 C.F.R. § 1.637 in the following respects. No statement of material facts was submitted by Tamai to support the motion as required by 37 C.F.R. § 1.637(a)(2). No copies of the JP '371 application and the PCT '947 application were served with the motion pursuant to 37 C.F.R. § 1.637(f)(2). No translation of the PCT '947 application was served with the motion pursuant to 37 C.F.R. § 1.637(f)(2).

Interference 103,662, Paper 31, p. 2.

F 12. Tamai filed a reply to Steven's opposition. Interference 103,662, Paper 39.

F 13. With respect to the failure to file a translation, Tamai again asserted that the translation of the Japanese domestic application "is also the substantial translation[\*5] of" the PCT because (1) that the PCT had "substantially the same specification" as the Japanese domestic application and (2) that the drawings of the two applications were identical. Interference 103,662, Paper 39, p. 11.

F 14. Tamai also submitted a declaration of Sadao Kinashi. Interference 103,662, Paper 40.

F 15. Kinashi testifies that he is fluent in the Japanese Language, that he reviewed the PCT and Japanese domestic applications, and that there are only minor variations in wording and placement of certain descriptions. Interference 103,662, Paper 40, p. 2.

F 16. The "bodies" of the Japanese language texts are said to be substantially identical, word for word. Interference 103,662, Paper 40, p. 1.

F 17. Kinashi also testifies that the translation of the Japanese domestic application is a true and faithful translation of the PCT. Interference 103,662, Paper 40, p. 2.

F 18. Pursuant to 37 CFR § 1.640(b), the decision on Tamai's preliminary motion for benefit was deferred to final hearing. Interference 103,662, Paper 45, p. 9 ("Motion H").

#### Final Hearing

F 19. Tamai filed a brief for final hearing. Interference 103,662, Paper 69.

F 20. Tamai's brief at final hearing[\*6] argued for the first time that the specification of Tamai's parent application constituted the required verified English translation and therefore, the required translation had been provided:

The '183 application is the verified English language translation of Tamai's PCT '947 application, satisfying the U.S. national stage entry requirements under 35 USC § 371 and 37 CFR § 1.494 [(1993)] n2 - paper no. 3 in the '183 file wrapper . . . .

n2 Rule 494 (1993) has been redesignated in the current rules as Rule 495 (2004).

Interference 103,662, Paper 69, p. 28 (bold and italics original).

F 21. While referring to Paper 3 in the U.S. parent application and both 35 U.S.C. § 371 (1991) and 37 CFR § 1.494(1993), Tamai did not explain how these provided the translation and affidavit required by 37 CFR §§ 1.637(f) and 1.647.

F 22. Sections 371 and Rule 494 relate to the processing of PCT applications in the PTO.

F 23. Section 371 specifies the requirements which must be met to begin U.S. national stage processing of a PCT application.

F 24. One of the requirements is to file an English language[\*7] translation of the PCT application. 35 U.S.C. § 371(c)(2) (1991).

F 25. Rule 494 also relates to entering national stage processing. It also requires the filing of an English language translation. 37 CFR § 1.494(c)(2) (1993).

F 26. Paper 3 in Application 08/030,183 is a notification that the PCT application met the requirements of 35 U.S.C. § 371 and 37 CFR § 1.494 and was accepted for examination in the PTO.

F 27. The paper states:

The applicant is hereby advised that the United States Patent and Trademark Office in its capacity as a designated Office, has determined that the above identified international application has met the requirements of 35 U.S.C. 371 and 37 CFR 1.494 and is accepted for national patentability examination in the United States Patent and Trademark Office.

Application 08/030,183, Paper 3.

F 28. Stevens' brief at final hearing again raised the issue that the original preliminary motion did not meet the requirements of 37 CFR § 1.637(f)(2) requiring, by reference to § 1.647, that a translation and affidavit of accuracy be filed with the motion. [\*8] Interference 103,662, Paper 72, p. 44.

F 29. A merits panel of the Board of Patent Appeals and Interferences entered a decision and opinion awarding priority against the junior party Stevens. Interference 103,662, Paper 78, p. 29.

F 30. As part of its opinion, the panel ruled on Tamai's deferred preliminary motion under 37 CFR § 1.633(f) for the priority benefit of the filing dates of the two earlier Japanese applications. Interference 103,662, Paper 78, pp. 20-23.

F 31. Because of the lack of a English translation, the panel denied the requested priority benefit of the filing date of the PCT. Interference 103,662, Paper 78, p. 22.

F 32. The panel, however, granted the motion with respect to the Japanese domestic application and accorded Tamai a priority benefit filing date of July 31, 1991. Interference 103,662, Paper 78, p. 23.

F 33. As a result, Tamai was held to have the earliest constructive reduction to practice date and the panel awarded judgment against Stevens. Interference 103,662, Paper 78, p. 29.

F 34. The panel held:

Because Tamai has established a constructive reduction to practice of July 31, 1991 and Stevens has established a constructive reduction [\*9] to practice of February 10, 1993, judgment is herein entered against Stevens.

Interference 103,662, Paper 78, p. 29.

F 35. Tamai filed a request for reconsideration of the panel's denial of the benefit of the filing date of the PCT application. Interference 103,662, Paper 79.

F 36. Tamai listed four reasons for requesting reconsideration: (1) representatives of the PTO already determined that a translation of the PCT application was present in Application 08/030,183, the parent application to Tamai's involved application; (2) Stevens did not identify any material discrepancies between the subject matter of the parent application and the PCT application; (3) Stevens had access to and the opportunity to examine the PCT application and translation; and (4) the Board's decision in holding that there was a constructive reduction to practice of the count in the parent application requires the same finding with respect to the PCT. Interference 103,662, Paper 79, p. 1.

F 37. The panel denied reconsideration. Interference 103,662, Paper 82.

F 38. With respect to the presence of a translation in the parent application, the panel noted that Tamai had not complied with 37 CFR §§ 1.637(f) [\*10] and 1.647. Interference 103,662, Paper 82, p. 2-3.

F 39. The panel rejected Tamai's argument, presented for the first time in the request for reconsideration, that the provisions of 37 CFR § 1.639 nullifies the requirements of §§ 1.637(f) and 1.647. Interference 103,662, Paper 82, pp. 3-4.

F 40. Section 1.639 provides that proof of any material fact must be provided with motions unless the proof relied upon is already part of an application that a party has already been accorded benefit. 37 CFR § 1.639.

F 41. In response to Tamai's additional new argument that it would be in the interest of justice to evaluate and consider the PCT application without a translation, the panel was of the view that granting a motion without a translation of the PCT application was contrary to the just, speedy and inexpensive determination of the interference. See 37 CFR § 1.601 and Interference 103,662, Paper 82, p. 5.

F 42. The panel particularly noted that Steven's was entitled to review a translation of the PCT to determine how to respond to the motion for benefit. Interference 103,662, Paper 82, p. 5.

F 43. Lastly, the panel addressed Tamai's argument that it was inconsistent to accord [\*11] the benefit of the Japanese domestic application and not accord the benefit of the PCT application. Interference 103,662, Paper 82, p. 5.

F 44. The panel noted that Stevens was in possession of an English translation of the Japanese domestic application but not of a translation of the Japanese PCT. Interference 103,662, Paper 82, p. 5.

F 45. The panel attributed the difference in result on benefit to Tamai's dissimilar submission of proofs for the two Japanese applications. Interference 103,662, Paper 82, p. 5.

#### Appeal to the Federal Circuit

F 46. Stevens appealed the panel's decision to the Federal Circuit.

F 47. Stevens argued that it was error to have accorded Tamai the benefit of the filing date of the Japanese domestic application. *Stevens*, 366 F.3d at 1330, 70 USPQ2d at 1769.

F 48. Stevens asserted that without the benefit of the filing date of the PCT application, the one year time period of 35 U.S.C. § 119(a) precludes according benefit to the Japanese domestic application. *Stevens*, 366 F.3d at 1330, 70 USPQ2d at 1769.

[\*12]

F 49. In response, Tamai argued that it was unnecessary and inappropriate to require Tamai to move for the benefit of the filing date of the PCT application and alternatively argued that Tamai had met the requirements for benefit of the PCT. *Stevens*, 366 F.3d at 1330, 70 USPQ2d at 1769.

F 50. Tamai argued that the PTO's acceptance of a translation of the PCT for entry into national stage processing under 35 U.S.C. § 371 was sufficient. *Stevens*, 366 F.3d at 1332, 70 USPQ2d at 1770.

F 51. The court construed Tamai's argument as asserting a conflict between the interference rules, 37 CFR §§ 1.601-1.690, and 35 U.S.C. §§ 363 and 371(c)(2). *Stevens*, 366 F.3d at 1332, 70 USPQ2d at 1771.

F 52. The Federal Circuit held that there was no conflict and that §§ 363 and 371(c)(2) were not inconsistent with the PTO procedural requirements requiring a party seeking benefit of an earlier non-English language application in an interference [\*13] to serve a translation and an affidavit attesting to the accuracy of the translation:

The conflict Tamai suggests simply does not exist. Sections 363 and 371(c)(2) are not inconsistent with the Office's procedural requirements which insist that a party to an interference seeking the benefit of an earlier filed application prove the same by filing a motion for benefit, and, where applicable, serving a translation of a relied upon non-English language application with an affidavit attesting to the accuracy of the translation. The former sections deal with accepting an international application into national stage examination in the United States while the latter regulations deal with proving whether the application contains a constructive reduction to practice of subject matter corresponding to a count in an interference. In short, in the context of this case, sections 363 and 371(c)(2), and 37 C.F.R. §§ 1.601-1.690, have little to do with one another.

*Stevens*, 366 F.3d at 1332, 70 USPQ2d at 1771.

F 53. The court also specifically noted that 35 U.S.C. § 372(b)(3) expressly authorizes[\*14] the Director to "require a verification of the translation of the international application or any other document pertaining to the application if the application or other document was filed in a language other than English." *Stevens*, 366 F.3d at 1333, 70 USPQ2d at 1771.

F 54. On the benefit issue, the court held that the panel was correct in denying benefit of the Japanese PCT application for failure to file a translation and attesting affidavit. *Stevens*, 366 F.3d at 1332, 70 USPQ2d at 1770.

F 55. However, the court reversed the panel's decision awarding priority against Stevens, holding that it was legal error to have accorded benefit to the Japanese domestic application which was filed more than a year before the filing of Tamai's U.S. parent application. *Stevens*, 366 F.3d at 1332, 70 USPQ2d at 1770.

F 56. The court remanded with instructions to enter judgment in favor of Stevens. *Stevens*, 366 F.3d at 1335, 70 USPQ2d at 1773.

F 57. [\*15] Tamai asked the Federal Circuit to reconsider its decision and suggested rehearing in banc. Interference 103,662, Paper 88.

F 58. Both were denied. Interference 103,662, Paper 89/

F 59. The Federal Circuit's mandate issued June 25, 2004 and was received by the Office on June 29, 2004. Interference 103,662, Paper 87.

#### Relief requested

F 60. In the paper titled "Senior Party Tamai Petition in Interference to Commissioner under 37 CFR 1.644(a)(2) and 37 CFR 1.182" (Interference 103,662, Paper 90) Tamai requests the following relief:

1. That the board acknowledge that July 24, 1992, the date on which the PCT application was filed in Japan, is the filing date of Tamai U.S. Application Serial No. 08/030,183 (Interference 103,662, Paper 90, p. 1);
2. that the board correct the record of this interference to state that the filing date of the PCT is the filing date of the of Tamai's U.S. parent application (Interference 103,662, Paper 90, p. 1);
3. That the provisions of 37 CFR § 1.647 be waived nunc pro tunc, suspended or held not to be effective with respect to Tamai's U.S. parent application (Interference 103,662, Paper 90, p. 1) because it is contrary to law as set forth in [\*16] PCT Article 27(1) and Rule 51<bis>.1(d)(ii) (Interference 103,662, Paper 90, p. 1);
4. That the burden be placed upon Stevens to show that the U.S. parent application is not a "complete and faithful" translation of the PCT application (Interference 103,662, Paper 90, p. 1);
5. That the board revise its decision and forward the revised decision to the Federal Circuit and request the Federal Circuit to modify or vacate that court's decision in *Stevens v. Tamai*, 366 F.3d 1325, 70 USPQ 1765 (Fed. Cir. 2004); and
6. That this interference be redeclared with Tamai being accorded the benefit of the July 24, 1992, filing date of Tamai's U.S. parent application (Interference 103,662, Paper 90, p. 1).

F 61. In the paper titled "Second Senior Party Tamai Petition in Interference to Commissioner under 37 C FR 1.644(a)(2), 37 CFR 1.644(a)(3) and 37 CFR 1.182" requests that the Director request the Court of Appeals for the Federal Circuit recall its mandate to allow the Director to become a party to the appeal and request appropriate relief. Interference 103,662, Paper 92, p. 1.

#### Discussion

##### Jurisdiction to decide these petitions[\*17]

The petitions relate to the conduct of this interference in the Office. Both petitions are said by Tamai to be under 37 CFR § 1.644(a)(2) and (3) and 37 CFR § 1.182. The first petition also raises waiver of an interference regulation under 37 CFR § 1.183. The authority to decide such petitions has been delegated by the Director to the Chief Administrative Patent Judge. MPEP § 1002.02(f)4a and b.

##### Requests to Modify the Board's Opinion, Reassign the Burden of Proof and Redeclare this Interference

Tamai's petition to modify the panel's opinion and decision, shift the burden of proof to Tamai and redeclare this interference (Interference 103,662, Paper 90) is denied.

Section 144 of 35 U.S.C. provides that on appeal, the Federal Circuit



shall review the decision from which an appeal is taken on the record before the Patent and Trademark Office. Upon its determination the court shall issue to the Director its mandate and opinion, which shall be entered of record in the Patent and Trademark Office and shall govern the further proceedings in the case.

Stevens sought judicial review of the Board's decision. The Federal Circuit reversed and remanded "with instructions to enter[\*18] judgment for Stevens." *Stevens v. Tamai*, 366 F.3d 1325, 1335, 70 USPQ2d 1765, 1773 (Fed. Cir. 2004). Tamai requested rehearing and suggested rehearing in banc. The Federal Circuit denied both requests. Interference 103,662, Paper 89. The Federal Circuit issued its mandate. Interference 103,662, Paper 87. The mandate and opinion of the Federal Circuit thus "govern[s] the further proceedings in the case." 35 U.S.C. § 144. The decision of the Federal Circuit is binding on the Office. The relief requested by Tamai in Paper 90 of this interference can not be granted. The petition is denied.

#### Requesting the Federal Circuit to Recall its Mandate

Tamai's second petition seeks to have a request filed with the Federal Circuit to recall the mandate issued by that court in *Stevens v. Tamai* so the Director may become a party to the appeal. Interference 103,662, Paper 92. Specifically, Tamai asks that the Director "file a motion under Federal Circuit Rule 27 for the Federal Circuit to recall the mandate and to reinstate the appeal for the purposes of the [Director] becoming a party to the interference [\*19]and requesting appropriate relief." Interference 103,662, Paper 92, p. 1. As an alternative, Tamai requests that the PTO file an appeal "asking the Federal Circuit to recall the mandate and reinstate the appeal for purposes of the [Director] becoming a party to the interference and requesting appropriate relief." Interference 103,662, Paper 92, p. 1.

The petition is denied. Implicit in the request is the assumption that the Federal Circuit's decision on appeal is somehow erroneous. There is no apparent basis raised in either petition which is convincing that the Office should ask the court to recall its mandate or enter a new and different decision. Indeed, upon review of the court's opinion, it is the view of the Office that the court has accurately stated what the practice in the Office should be under the interference rule. There is simply no reason to ask the Federal Circuit to recall its mandate.

#### Legal Topics:

For related research and practice materials, see the following legal topics:

Patent Law: Claims & Specifications: Enablement Requirement: General Overview

Patent Law: Inequitable Conduct: General Overview

Patent Law: U.S. Patent & Trademark Office Proceedings: Patent Cooperation Treaty & Provisional Applications